REMARKS/ARGUMENT

1) Claims 1, 2, 5, 7-13, 15-18 and 20-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher et al (20041922211) in view of Wesby et al (6,799,044). Applicants respectfully traverse this rejection, as set forth below.

Applicants respectfully point out that, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Independent Claim 1 requires and positively recites a system for supporting wireless communication, comprising: “a first fixed-site wireless communication apparatus”, “a second fixed-site wireless communication apparatus” and “a wired communication channel connected between said first fixed-site wireless communication apparatus and said second fixed-site wireless communication apparatus, said first fixed-site wireless communication apparatus for **receiving from a wireless mobile communication apparatus information, including identification of frequency channels available for receiving and transmitting information, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established**, said first fixed-site wireless communication apparatus further for communicating said information to said to said second fixed-site wireless communication apparatus via said wired communication channel”.

Independent Claim 16 requires and positively recites, a method of supporting wireless communication, comprising: “a first fixed-site wireless communication apparatus **receiving from a wireless mobile communication apparatus information, including identification of frequency channels available for receiving and transmitting information, for use in determining whether a desired wireless communication session involving the wireless**

mobile communication apparatus will be established" and "using a wired communication channel to communicate the information from the first fixed-site wireless communication apparatus to a second fixed-site wireless communication apparatus".

In contrast, Gallagher teaches an apparatus for supporting the handover of a telecommunication session between a licensed wireless system and an unlicensed wireless system in which the mobile switching center 26 identifies and determines the frequency channels that will be used to communicate to and from subscriber device 12. Examiner admits that Gallagher fails to disclose wherein said information received by the first fixed wireless communication apparatus from wireless mobile communication apparatus (subscriber device 12) includes identification of frequency channels available for receiving and transmitting. Examiner, however, relies upon Wesby as providing the above omitted teaching in Gallagher.

Wesby discloses a method for a radio channel allocation for telecommunication networks, comprising fixed transceivers (BTS) and fixed or mobile radio stations (MS). The method comprises a step of performing channel allocation (by the base station) for a particular radio connection to a radio station based upon signal to interference estimates for the radio station (Abstract, lines 1-6). More particularly, Wesby teaches the following:

> In more detail than in FIG. 4 **the BSC identifies the cell corresponding to each BCCH FS measurement reported by a MS knowing the BCCH frequency and the base station identify code BSIC**. Although BSIC and BCCH frequency in general do not uniquely identify a cell the BSC identifies the cell nevertheless by other means (col. 7, lines 22-27).

Therefore:

(1) The BSC (base station controller) knows the BCCH frequency, as it is assigned by the base station and reported by the base station to the BSC. The mobile radio station (MS) did not, and DOES NOT choose the BCCH frequency.

(2) The BSC (base station controller) knows the base stations' identity, because that was set during the installation of the base station. By inference, the mobile radio station (MS) does NOT at any time select or identify "the frequency channels available for transmitting and receiving information", other than the one it was assigned by the BSC.

In light of the above, it is clear that Examiner has misinterpreted the teaching of Wesby. Wesby does NOT teach or suggest that its mobile station identifies to a base station, "frequency channels available for the mobile station to communicate with the base station. As such, any combination of Gallagher and Wesby fails to teach or suggest, "said first fixed-site wireless communication apparatus for **receiving** **from a wireless mobile communication apparatus information, including identification of frequency channels available for receiving and transmitting information, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established**", as required by Claim 1, OR "a first fixed-site wireless communication apparatus **receiving** **from a wireless mobile communication apparatus information, including identification of frequency channels available for receiving and transmitting information, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established**", as required by Claim 16. Accordingly, the 35 U.S.C. 103(a) rejection of Claims 1 and 16 is overcome.

Claims 2, 3, 5, 7-13, 15, 17, 18 and 20-26 stand allowable as depending from allowable claims and including further limitations not taught or suggested by the references of record.

In proceedings before the Patent and Trademark Office, "the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art". In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). "The Examiner can satisfy this burden **only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references**", In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.** In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Moreover, **it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.** In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. As discussed above, Examiner has failed to set forth any legitimate suggestion or motivation, either in the references themselves or in the knowledge generally available to one or ordinary skill in that art, to combine and modify Gallagher and

Wesby, as suggested by Examiner. Second, there must be a reasonable expectation of success. In lieu of Examiner's misinterpretation of Wesby, there is no possibility whatsoever that a combination of the Gallagher and Wesby teachings will result in the device of Applicants' claims 1 and 16. Finally, the prior art reference (or references when combined) must teach or suggest ALL the claim limitations (MPEP § 2143). As stated previously, any combination of Gallagher and Wesby fails to teach or suggest, "said first fixed-site wireless communication apparatus for **receiving from a wireless mobile communication apparatus information, including identification of frequency channels available for receiving and transmitting information, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established**", as required by Claim 1, OR "a first fixed-site wireless communication apparatus **receiving from a wireless mobile communication apparatus information, including identification of frequency channels available for receiving and transmitting information, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established**", as required by Claim 16. Applicants respectfully submit that the Examiner has failed to establish all three criteria. Thus, Claims 1 and 16 (and dependent Claims 2, 3, 5, 7-13, 15, 17, 18 and 20-26) are patentable under 35 U.S.C. § 103(a) over Gallagher in view of Wesby.

2) Claims 4 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher et al (20040192211) in view of Wesby et al (6,799,044) as applied to claims 1 and 16 above, in view of Kil (20010046855). Applicants respectfully traverse this rejection as follows:

Claim 4 further defines the system of Claim 1, wherein said information is indicative of wireless communication resource use in a previous wireless communication session involving the wireless mobile communication apparatus.

Claim 4 depends directly from Claim 1. Independent Claim 1, as amended, requires and positively recites, a system for supporting wireless communication, comprising: "a first fixed-site wireless communication apparatus", "a second fixed-site wireless communication apparatus" and "a wired communication channel connected between said first fixed-site wireless communication apparatus and said second fixed-site wireless communication apparatus, said first fixed-site wireless communication apparatus for receiving from a wireless mobile communication apparatus information, **including identification of frequency channels available for receiving and transmitting information**, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established, said first fixed-site wireless communication apparatus further for communicating said information to said to said second fixed-site wireless communication apparatus via said wired communication channel".

Claim 19 further defines the method of Claim 16, wherein said information is indicative of wireless communication resource use in a previous wireless communication session involving the wireless mobile communication apparatus.

Claim 19 depends directly from Claim 16. Independent Claim 16, as amended, requires and positively recites, a method of supporting wireless communication, comprising: "a first fixed-site wireless communication apparatus receiving from a wireless mobile communication apparatus information, **including identification of frequency channels available for receiving and transmitting information**, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established" and "using a wired communication channel to communicate the information from the first fixed-site wireless communication apparatus to a second fixed-site wireless communication apparatus".

In contrast, Gallagher teaches an apparatus for supporting the handover of a telecommunication session between a licensed wireless system and an unlicensed wireless system in which the mobile switching center 26 identifies and determines the frequency channels that will be used to communicate to and from subscriber device 12. Examiner admits that Gallagher fails to disclose wherein said information received by the first fixed wireless communication apparatus from wireless mobile communication apparatus (subscriber device 12) includes identification of frequency channels available for receiving and transmitting. Examiner, however, relies upon Wesby as providing the above omitted teaching in Gallagher.

Wesby discloses a method for a radio channel allocation for telecommunication networks, comprising fixed transceivers (BTS) and fixed or mobile radio stations (MS). The method comprises a step of performing channel allocation (by the base station) for a particular radio connection to a radio station based upon signal to interference estimates for the radio station (Abstract, lines 1-6). More particularly, Wesby teaches the following:

> In more detail than in FIG. 4 **the BSC identifies the cell corresponding to each BCCH FS measurement reported by a MS knowing the BCCH frequency and the base station identify code BSIC**. Although BSIC and BCCH frequency in general do not uniquely identify a cell the BSC identifies the cell nevertheless by other means (col. 7, lines 22-27).

Therefore:

(3) The BSC (base station controller) knows the BCCH frequency, as it is assigned by the base station and reported by the base station to the BSC. The mobile radio station (MS) did not, and DOES NOT choose the BCCH frequency.

(4) The BSC (base station controller) knows the base stations' identity, because that was set during the installation of the base station. By inference, the mobile radio station (MS) does NOT at any time select or identify "the frequency channels available for

transmitting and receiving information", other than the one it was assigned by the BSC.

In light of the above, it is clear that Examiner has misinterpreted the teaching of Wesby. Wesby does NOT teach or suggest that its mobile station identifies to a base station, "frequency channels available for the mobile station to communicate with the base station. As such, any combination of Gallagher and Wesby fails to teach or suggest, "said first fixed-site wireless communication apparatus for **receiving from a wireless mobile communication apparatus information, including identification of frequency channels available for receiving and transmitting information, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established**", as required by Claim 1, OR "a first fixed-site wireless communication apparatus **receiving from a wireless mobile communication apparatus information, including identification of frequency channels available for receiving and transmitting information, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established**", as required by Claim 16. Claim 4 depends from Claim 1 and Claim 19 depends from Claim 16.

Even if, arguendo, Kil teaches what is suggested by the Examiner on page 10, line 17 – page 11, line 2 of the Office Action dated December 7, 2006, Kil fails to teach or suggest, "...receiving from a wireless mobile communication apparatus information, **including identification of frequency channels available for receiving and transmitting information**, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established ... ", as required by Claim 1. Claim 4 depends from Claim 1 and is allowable for the same reasons set forth above in support of the allowance of Claim 1.

Similarly, Kil fails to teach or suggest, “a first fixed-site wireless communication apparatus receiving from a wireless mobile communication apparatus information, **including identification of frequency channels available for receiving and transmitting information,** for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established”, as required by Claim 19. Claim 19 depends from Claim 16 and is allowable for the same reasons set forth above in support of the allowance of Claim 16. The 35 U.S.C. 103(a) rejection of Claims 4 and 16 is overcome.

In proceedings before the Patent and Trademark Office, “the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art”. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). “The Examiner can satisfy this burden **only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references**”, In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.** In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Moreover, **it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.** In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985).

Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." _In re Wilson_, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). It is clear from the above analysis that all of the words of Claims 4 and 19 cannot be found in a combination of the Gallagher and Kil references, as is required by law. As such, the 35 U.S.C. 103(a) rejection of Claims 4 and 19 must be withdrawn.

3) Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher et al (20040192211) in view of Wesby et al. (6,799,044) as applied to claim 1 above, and further in view of Musikka et al (20020015392). Applicants respectfully traverse this rejection as follows:

Claim 6 further defines the system of Claim 1, wherein said wired communication channel utilizes internet protocol (IP) to communicate said information from said first fixed-site wireless communication apparatus to said second fixed-site wireless communication apparatus.

Claim 6 depends directly from Claim 1. Independent Claim 1, as amended, requires and positively recites, a system for supporting wireless communication, comprising: “a first fixed-site wireless communication apparatus”, “a second fixed-site wireless communication apparatus” and “a wired communication channel connected between said first fixed-site wireless communication apparatus and said second fixed-site wireless communication apparatus, said first fixed-site wireless communication apparatus for receiving from a wireless mobile communication apparatus information, **including identification of frequency channels available for receiving and transmitting information**, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established, said first fixed-site wireless communication apparatus further for communicating said information to said to said second fixed-site wireless communication apparatus via said wired communication channel”.

In contrast, Gallagher teaches an apparatus for supporting the handover of a telecommunication session between a licensed wireless system and an unlicensed wireless system in which the mobile switching center 26 identifies and determines the frequency channels that will be used to communicate to and from subscriber device 12. Examiner admits that Gallagher fails to disclose wherein said information received by the first fixed wireless communication apparatus from wireless mobile communication apparatus (subscriber device 12) includes identification of frequency channels available for receiving and transmitting. Examiner, however, relies upon Wesby as providing the above omitted teaching in Gallagher.

Wesby discloses a method for a radio channel allocation for telecommunication networks, comprising fixed transceivers (BTS) and fixed or mobile radio stations (MS). The method comprises a step of performing channel allocation (by the base station) for a particular radio connection to a radio station based upon signal to interference estimates for the radio station (Abstract, lines 1-6). More particularly, Wesby teaches the following:

> In more detail than in FIG. 4 **the BSC identifies the cell corresponding to each BCCH FS measurement reported by a MS knowing the BCCH frequency and the base station identify code BSIC**. Although BSIC and BCCH frequency in general do not uniquely identify a cell the BSC identifies the cell nevertheless by other means (col. 7, lines 22-27).

Therefore:

(5) The BSC (base station controller) knows the BCCH frequency, as it is assigned by the base station and reported by the base station to the BSC. The mobile radio station (MS) did not, and DOES NOT choose the BCCH frequency.

(6) The BSC (base station controller) knows the base stations' identity, because that was set during the installation of the base station. By inference, the mobile radio station

> (MS) does NOT at any time select or identify "the frequency channels available for transmitting and receiving information", other than the one it was assigned by the BSC.

In light of the above, it is clear that Examiner has misinterpreted the teaching of Wesby. Wesby does NOT teach or suggest that its mobile station identifies to a base station, "frequency channels available for the mobile station to communicate with the base station. As such, any combination of Gallagher and Wesby fails to teach or suggest, "said first fixed-site wireless communication apparatus for **receiving from a wireless mobile communication apparatus information, including identification of frequency channels available for receiving and transmitting information, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established**", as required by Claim 1. Claim 6 depends from Claim 1.

Even if, arguendo, Musikka teaches what is suggested by the Examiner on page 12, lines 7-12 of the Office Action dated December 7, 2006, Musikka fails to teach or suggest, "...receiving from a wireless mobile communication apparatus information, **including identification of frequency channels available for receiving and transmitting information,** for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established ... ", as required by Claim 1. Claim 6 depends from Claim 1 and is allowable for the same reasons set forth above in support of the allowance of Claim 1.

In proceedings before the Patent and Trademark Office, "the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art". *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). "The Examiner can satisfy this burden **only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary**

skill in the art would lead that individual to combine the relevant teachings of the references", *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.** *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127. Moreover, **it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.** *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985).

Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). It is clear from the above analysis that all of the words of Claim 6 cannot be found in a combination of the Gallagher and Musikka references, as is required by law. As such, the 35 U.S.C. 103(a) rejection of Claim 6 must be withdrawn.

4) Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher et al (20040192211) in view of Wesby et al (6,799,044) as applied to claim 1 above, and further in view of Ezaki (6,594,485). Applicants respectfully traverse this rejection as follows:

Claim 14 further defines the system of Claim 1, wherein said second fixed-site wireless communication apparatus is for receiving from a further wireless mobile communication apparatus further information for use in determining whether a further desired wireless communication session involving the further wireless mobile communication apparatus will be established, said second fixed-site wireless communication apparatus further for communicating said further information to said first fixed-site wireless communication apparatus via said wired communication channel.

Claim 14 depends directly from Claim 1. Independent Claim 1, as amended, requires and positively recites, a system for supporting wireless communication, comprising: "a first fixed-site wireless communication apparatus", "a second fixed-site wireless communication apparatus" and "a wired communication channel connected between said first fixed-site wireless communication apparatus and said second fixed-site wireless communication apparatus, said first fixed-site wireless communication apparatus for receiving from a wireless mobile communication apparatus information, **including identification of frequency channels available for receiving and transmitting information**, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established, said first fixed-site wireless communication apparatus further for communicating said information to said to said second fixed-site wireless communication apparatus via said wired communication channel".

In contrast, Gallagher teaches an apparatus for supporting the handover of a telecommunication session between a licensed wireless system and an unlicensed wireless system in which the mobile switching center 26 identifies and determines the frequency channels that will be used to communicate to and from subscriber device 12. Examiner admits that Gallagher fails to disclose wherein said information received by the first fixed wireless communication apparatus from wireless mobile communication apparatus (subscriber device 12) includes identification of frequency channels available for receiving and transmitting. Examiner, however, relies upon Wesby as providing the above omitted teaching in Gallagher.

Wesby discloses a method for a radio channel allocation for telecommunication networks, comprising fixed transceivers (BTS) and fixed or mobile radio stations (MS). The method comprises a step of performing channel allocation (by the base station) for a particular radio connection to a radio station based upon signal to interference estimates for the radio station (Abstract, lines 1-6). More particularly, Wesby teaches the following:

> In more detail than in FIG. 4 **the BSC identifies the cell corresponding to each BCCH FS measurement reported by a MS knowing the BCCH frequency and the base station identify code BSIC**. Although BSIC and BCCH frequency in general do not uniquely identify a cell the BSC identifies the cell nevertheless by other means (col. 7, lines 22-27).

Therefore:

(7) The BSC (base station controller) knows the BCCH frequency, as it is assigned by the base station and reported by the base station to the BSC. The mobile radio station (MS) did not, and DOES NOT choose the BCCH frequency.

(8) The BSC (base station controller) knows the base stations' identity, because that was set during the installation of the base station. The mobile radio station (MS) does NOT at any time know "the frequency channels available for transmitting and receiving information.

In light of the above, it is clear that Examiner has misinterpreted the teaching of Wesby. Wesby does NOT teach or suggest that its mobile station identifies to a base station, "frequency channels available for the mobile station to communicate with the base station. As such, any combination of Gallagher and Wesby fails to teach or suggest, "said first fixed-site wireless communication apparatus for **receiving from a wireless mobile communication apparatus information, including identification of frequency channels available for receiving and transmitting information, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established**", as required by Claim 16. Claim 14 depends from Claim 1.

Even if, arguendo, Ezaki teaches what is suggested by the Examiner on page 13, lines 12-20 of the Office Action dated December 7, 2006, Ezaki fails to teach or suggest, "...receiving from a wireless mobile communication apparatus information, **including identification of frequency channels available for receiving and transmitting information**, for use in determining whether a desired wireless communication session involving the wireless mobile communication apparatus will be established ... ", as required by Claim 1. Claim 14 depends from Claim 1 and is allowable for the same reasons set forth above in support of the allowance of Claim 1.

In proceedings before the Patent and Trademark Office, "the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art". *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). "The Examiner can satisfy this burden **only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references**", *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.** *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127. Moreover, **it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.** *In re Gorman*, 933

F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985).

Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). It is clear from the above analysis that all of the words of Claim 14 cannot be found in a combination of the Gallagher and Ezaki references, as is required by law. As such, the 35 U.S.C. 103(a) rejection of Claim 14 must be withdrawn.

Claims 27 & 28 stand allowed. In light of the above arguments, Claims 1-26 similarly stand allowable. Applicants respectfully request withdrawal of the rejections and allowance of the application as the earliest possible date.

Respectfully submitted,

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